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REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed July 12, 2005. In the Office Action, the Examiner notes that claims 1, 2, 4-13 and 15-57 are pending and rejected. By this response, claims 1, 11, 23, 31, 41, 56 and 57 have been amended.

In view of both the amendments presented above and the following discussion, Applicants submit that all of the claims comply with the written description requirement of 35 U.S.C. §112, paragraph 1, and none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103.

It is to be understood that Applicants, by making the above amendments, do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response including amendments.

Amendments to the Claims

By this response, claims 1, 11, 23, 31, 41, 56 and 57 have been amended. The amendments to the claims are fully supported by the Specification, Drawings and Claims as originally filed in the 07/991,074 parent application. For example, the amendments to claims 1, 11, 23, 31 and 41 are supported at least by the first paragraph on page 54 and the paragraph spanning pages 57-58 of the 07/991,074 parent application. The amendments to claims 56 and 57 are supported at least by the middle paragraph on page 55 of the 07/991,074 parent application. Thus, no new matter has been added, and the Examiner is respectfully requested to enter the amendments to the claims. Furthermore, it is respectfully submitted that the amended claims are fully supported by the 07/991,074 parent application and thus properly have a priority date which is the filing date of the 07/991,074 parent application, i.e., December 9, 1992.

35 U.S.C. §112 Rejection

The Examiner has rejected claims 1, 11, 23, 31 and 41 under 35 U.S.C. §112, paragraph 1, as failing to comply with the written description requirement. Applicants

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respectfully traverse the rejection. Specifically, the Examiner alleges: "In particular, the specification does not disclose a hardware upgrade which comprises an interface to the set top terminal for receiving and processing subscriber input."

In response the Applicants have amended the rejected claims to remove claim language that recites that the interface is for receiving and processing subscriber input. Thus, the reasons for rejection are obviated, and the Applicants respectfully request that the Examiner's rejection be withdrawn.

However, the Applicants hereby note that some form of receiving and processing of subscriber input by the interface may be inherent to the Level C interactive hardware upgrade as described in the 07/991,074 parent application.

35 U.S.C. §103 Rejection of Claims 1, 2, 3, 4, 6-13, 16-36, 38-44 and 47-56

The Examiner has rejected claims 1, 2, 3, 4, 6-13, 16-36, 38-44 and 47-56 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,583,560 to Florin (hereinafter "Florin") in view of U.S. Patent 5,483,277 to Granger (hereinafter "Granger") and U.S. Patent 5,192,999 to Graczyk (hereinafter "Graczyk"). Applicants respectfully traverse the rejection.

The present application is a divisional of U.S. Patent No. 5,990,927, filed December 2, 1993, which is a continuation-in-part of U.S. Patent Application No. 07/991,074, filed December 9, 1992. The limitations of claim 1, as amended, are fully supported by the disclosure of the 07/991,074 parent application, and thus have a priority date of December 9, 1992.

The Examiner has alleged, regarding the priority date of the claims (emphasis included in the original recitation):

"applicant has not provided sufficient evidence to support the priority claims to the 07/991,074. In particular, where teachings of a hardware upgrade which comprises an interface to the set top terminal for receiving and processing subscriber input." (page 2 of the 7/12/05 Office Action)

In response, the Applicants have amended the independent claims to remove the allegedly unsupported language regarding the interface for receiving and processing subscriber input.

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Independent claim 1 has additionally been amended to recite, in relevant part (emphasis added below):

“an interface to the set top terminal for communicating data and video signals between the set top terminal and the hardware upgrade.”

Support in the 07/991,074 parent application for this portion of the amended claim 1 is in the first paragraph on page 54 and the paragraph spanning pages 57-58. For support for the other claim language in claim 1, please refer to the comments on pages 13-14 of the Response accompanying the RCE filed on 4/11/05. Thus, all of the limitations of claim 1 can be found disclosed in the 07/991,074 parent application.

Therefore, neither the Florin reference, filed June 22, 1993, nor the Granger reference, filed December 15, 1992, are prior art against claim 1, because these references have priority dates after the priority date of claim 1. Thus, the rejection becomes a 35 USC 103(a) rejection over the Graczyk reference.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. The Graczyk reference fails to teach or suggest all of the limitations recited in claim 1, and thus fails to teach or suggest the Applicants' invention as a whole.

The Graczyk reference discloses a television circuit and an audio multimedia circuit which can be used with a personal computer (see abstract). However, the Graczyk reference does not teach or suggest many limitations of claim 1 as amended. For example, inter alia, the Graczyk reference does not teach or suggest a hardware upgrade for a set top terminal.

Thus, the Graczyk reference fails to teach or suggest the Applicants' invention as a whole.

As such, Applicants submit that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claims 11, 23, 31 and 42 have relevant limitations that are similar to those discussed above in regards to claim 1. Therefore, independent claims 11, 23, 31 and 42 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 2, 3, 4, 6-10, 12-13, 15-30, 32-36, 38-41, 43 and 47-56 depend, either directly or indirectly, from independent claims 1, 11, 23, 31

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and 42 and recite additional limitations thereof. As such, Applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

35 U.S.C. §103 Rejection of Claims 5, 37, 45, 46 and 57

The Examiner has rejected claims 5, 37, 45, 46 and 57 under 35 U.S.C. §103(a) as being unpatentable over Florin in view of Granger and Graczyk in further view of U.S. Patent 5,638,426 to Lewis (hereinafter "Lewis") and U.S. Patent 5,247,575 to Sprague (hereinafter "Sprague"). Applicants respectfully traverse the rejection.

As discussed above, Florin and Granger are not prior art with respect to the independent claims 1, 31 and 41. Furthermore, for at least the reasons discussed above, Graczyk does not teach or suggest Applicants' Invention as a whole, as recited in independent claims 1, 31 and 41. Accordingly, any attempted combination of the Graczyk reference with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claims. As such, Applicants submit that dependent claims 5, 37, 45, 46 and 57 are also not obvious and are patentable under 35 U.S.C. §103.

35 U.S.C. §103 Rejection of Claim 15

The Examiner has rejected claim 15 under 35 U.S.C. §103(a) as being unpatentable over Florin in view of Granger and Graczyk in further view of U.S. Patent 5,432,542 to Thilbadeau (hereinafter "Thilbadeau"). Applicants respectfully traverse the rejection.

As discussed above, Florin and Granger are not prior art with respect to the independent claim 11. Furthermore, for at least the reasons discussed above, Graczyk does not teach or suggest Applicants' Invention as a whole, as recited in independent claim 11. Accordingly, any attempted combination of the Graczyk reference with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claim. As such, Applicants submit that dependent claim 15 is also not obvious and is patentable under 35 U.S.C. §103.

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35 U.S.C. §103 Rejection of Claims 17-18

The Examiner has rejected claims 17-18 under 35 U.S.C. §103(a) as being unpatentable over Florin in view of Granger and Graczyk in further view of U.S. Patent 4,920,339 to Friend (hereinafter "Friend"). Applicants respectfully traverse the rejection.

As discussed above, Florin and Granger are not prior art with respect to the independent claim 11. Furthermore, for at least the reasons discussed above, Graczyk does not teach or suggest Applicants' invention as a whole, as recited in independent claim 11. Accordingly, any attempted combination of the Graczyk reference with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claim. As such, Applicants submit that dependent claims 17-18 are also not obvious and are patentable under 35 U.S.C. §103.

CONCLUSION

Thus, Applicants submit that none of the claims presently in the application are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Stephen Guzzi at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 10/7/05

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